



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,979	01/22/2004	George Hradil	81394-499	7882
28765	7590	05/31/2006	EXAMINER	
WINSTON & STRAWN LLP 1700 K STREET, N.W. WASHINGTON, DC 20006			WONG, EDNA	
			ART UNIT	PAPER NUMBER
			1753	

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/763,979

Applicant(s)

HRADIL, GEORGE

Examiner

Edna Wong

Art Unit

1753

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 May 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

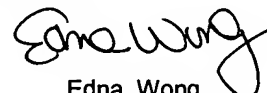
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 19 and 21-37.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See pages 2-4.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.


Edna Wong
Primary Examiner
Art Unit: 1753

ADVISORY ACTION

This is in response to the Amendment dated May 22, 2006. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Arguments

Claim Objections

Claim **35** has been objected to because of minor informalities.

The rejection of claim 35 has been withdrawn in view of Applicant's amendment.

Claim Rejections - 35 USC § 112

Claims **27-28 and 33** have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejection of claims 27-28 and 33 under 35 U.S.C. 112, second paragraph, has been withdrawn in view of Applicant's amendment.

Claim Rejections - 35 USC § 103

I. Claims **19 and 21-31** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **JP 2-301588** ('588).

The rejection of claims 19 and 21-31 under 35 U.S.C. 103(a) as being

unpatentable over JP 2-301588 ('588) is as applied in the Office Actions dated November 9, 2005 and February 22, 2006 and incorporated herein. The rejection has been maintained for the following reasons:

Applicant states that the present invention requires a pH of between 3.5 and 5.5 and preferably around 4 for best results. Thus, the skilled artisan is not motivated to use the presently claimed pH range.

In response, JP '588 teaches a pH of 2~9. It is better to plate at pH 3~8.5, or best at pH 5~8 (page 4, lines 13-15). From these teachings, the skilled artisan would have been motivated to use a pH of 3~8.5 because it was better to plate at this range, and thus, to use a pH of between 3.5 and 5.5 which is within this specific range.

Applicant states that a skilled artisan is not led to combine the presently claimed pH range and the complexing agent to metal ion ratio in a particular electroplating solution, nor to use such a solution to minimize agglomeration of the substrates during electroplating.

In response, Applicant's Declaration shows the solution of Example 1 (at a pH of 7 and a complexing agent to metal ion ratio of 10:1) as disclosed in the JP '588 reference. Applicant photographs this solution at various intermediate pH values to illustrate that condition of the solution. Since JP '588 teaches a pH of 2~9, what is the condition of the solution at the non-preferred pH values and at the non-preferred complexing agent to metal ion ratios because the discovery of a previously

unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer (MPEP § 2112(I)).

The scope of Applicant's Declaration does not convince the Examiner that the presently claimed pH range and the complexing agent to metal ion ratio is anything new from the disclosure of JP '588 when the solution of JP '588 would have successfully functioned the same at the non-preferred values.

II. Claims **32-37** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **JP 2-301588** ('588).

JP '588 is as applied for the reasons as discussed above and incorporated herein.

Response to Amendment

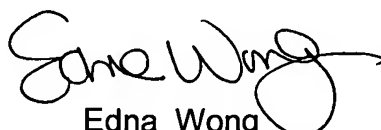
The declaration under 37 CFR 1.132 filed May 22, 2006 is insufficient to overcome the rejection of claims 19 and 21-37 based upon a specific reference applied under 35 USC 103 as set forth in the last Office action because: the showing is not commensurate in scope with the specific reference.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edna Wong whose telephone number is (571) 272-

1349. The examiner can normally be reached on Mon-Fri 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Edna Wong
Primary Examiner
Art Unit 1753

EW
May 29, 2006

